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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,532	03/17/2004	Tsuyoshi Inagaki	249-331	2297

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,532

Applicant(s)

INAGAKI ET AL.

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/2/2005
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 & 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Upon allowance of the claimed resin composition and pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, would be subject to being rejoined. Process claim 9, would at that time, be rejoined and fully examined for patentability under 37 CFR 1.104.

2. Claim 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 25, 2005.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

((b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO02065567 (as translated by its English language equivalent EP 1351329).

WO '567 discloses a polymer electrolyte fuel cell comprising a composition comprising a binder, conductive carbon particles and at least one of conductive carbon fine particles and micro-diameter carbon fibers. In example 2, the reference discloses a composition comprising 100 g of a liquid oligomer, 20 g of carbon nano-tubes with a fiber diameter of 10 to 30 nm, 100 g graphite powder, 50 g carbon black and 30 g graphite fiber. In said composition the total amount of conductive filler, i.e., carbon fiber, graphite powder, graphite fiber and carbon black is 200g (or about 66% by weight based on total composition) and the total amount of resin is 100 g (or about 33% by weight based on total composition).

The composition of the reference meets the requirements of the above-rejected claims both in terms of the types of materials added and their contents. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

As presently recited, the claimed conductive filler component does not exclude fillers other than graphite powder and fine carbon fiber.

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1061597.

EP '597 discloses a fuel cell separator comprising (a) about 100 pbw of graphitized meso-carbon microbeads, (b) about 10 to 35 pbw of a resin and (c) about 1 to 40 pbw of at least one carbonaceous material selected from the group consisting of graphite powder, carbon black and fine carbon fibers. In Tables 3 and 5, the reference discloses examples 7 and 13 compositions comprising between 30-35 pbw resin, 100 pbw graphitized meso-carbon microbeads, 10 pbw artificial graphite powder and between 15-20 pbw of carbon nano-tubes. In

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said compositions the total amount of conductive filler, i.e., carbon nano-tubes, graphite powder and graphitized meso-carbon microbeads is between 115-130 pbw (or about 80% by weight based on total composition) and the total amount of resin is between 30-35 pbw (or about 20% by weight based on total composition).

The compositions of the reference meet the requirements of the above-rejected claims both in terms of the types of materials added and their contents. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

As presently recited, the claimed conductive filler component does not exclude fillers other than graphite powder and fine carbon fiber.

Claim Rejections - 35 USC § 103

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO02065567 (as translated by its English language equivalent EP 1351329), described hereinabove.

As to the particular weight ratios per said claims, it is within the purview of the reference to utilize the materials in said amounts. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

8. Claims 2 and 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1061597 described hereinabove.

EP '597 discloses carbon black as one type of carbonaceous materials that can be used (see Tables). Accordingly, the further use of carbon black in the reference compositions for its expected additive effect would have been obvious to one having ordinary skill in the art. As to

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the particular weight ratios per claims 5-7, it is within the purview of the reference to utilize the materials in said amounts. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed subject matter.

Response to Arguments

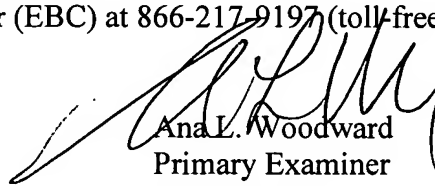
9. Applicant's amendments and arguments filed November 2, 2005 have been fully considered and are persuasive to the extent that the rejections over Chacko have been withdrawn.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


Ana L. Woodward
Primary Examiner
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